REMARKS

This amendment is in response to the Official Action dated May 23, 2007. Claims 2-4, 6, and 9-13 have been cancelled, and claims 14-22 have been added, as such claims 1, 5, 7, 8, and 14-22 are now pending in this application. Claims 1, 7, and 14-16 are independent claims. Reconsideration and allowance is requested in view of the claim amendments and the following remarks.

No new matter has been added by this Amendment. Support for the new claims can be found in the former claims, figures 1-4, and the specification as filed.

Claim Rejections under 35 U.S.C. 102(b)

At least for the following reasons, if the allowance of the claims is not forthcoming and a new ground of rejection made, then a new non-final Office Action is respectfully requested.

Claim 1, 3, 5, and 7- 8 have been rejected under 35 U.S.C. § 102(b) as anticipated by **Searby** (U.S. Patent No. 5,412,402).

MPEP § 2131 sets forth that:

> "A claim is anticipated **only if each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

> "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

> "**The elements must be arranged as required by the claim,** but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Searby discloses an electronic graphic system for use in the painting of an image.

Existing control image data (K) in control image store 14 is streamed to comparator 13. New control image data, K_B is also streamed to comparator 13. Comparator 13 outputs a single control signal representing the relationship between the existing control data (K) and new control data (K_B), i.e., the single control signal indicates whether K and K_B are different. The output of comparator 13 is the input to gate 15. Gate 15 also receives the new control data (K_B). When the input to gate 15 from comparator 13 indicates that K and K_B differ, then gate 15 allows the new control data (K_B) to be input to control image store 14 and replace the existing data (K). (Searby at 7:22-39).

Figure I

Since gate 15 only allows new data to pass to control image store 14 when the existing control data (K) differs from new control data (K_B), **comparator 13 does not need to employ a specific read or write signal.** Instead the comparator produces a write signal in response to changes in the streamed data.

The combination of comparator 13 and gate 15 does not operate in accordance with any read or write control signal. Instead gate 15 only receives a write signal from comparator 13 in response to the data only. While in combination comparator 13 and gate 15 functionally (i) compare new control data (K_B) with the existing control data (K) from the control image store; and (ii) write the new control data to the control image store; **none of this activity depends on a read or write signal for a control signal generating section.**

Claim 1 recites: *[a] data storage circuit characterized by providing a comparison section for reading out existing data stored in a storage element to compare said existing data and new data with each other prior to writing of said new data to said storage element, and configuring so that, in said comparison section, in a case where said existing data and said new data are identical with each other, the writing to said storage element is not performed, and in a case where said existing*
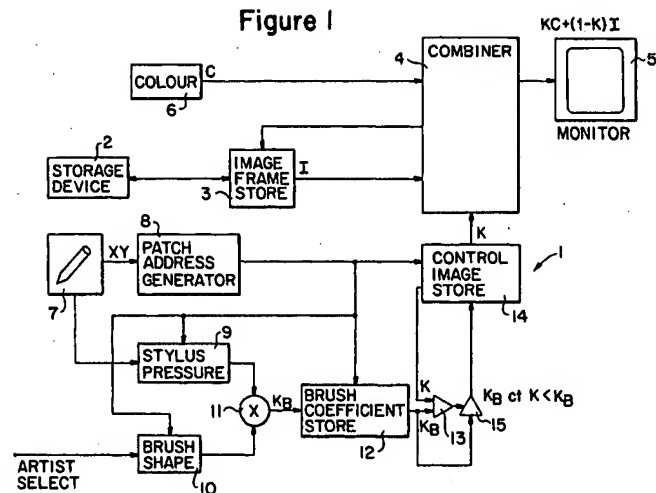
data and said new data are not identical with each other, said new data is written to said storage element; and

characterized by providing a control signal generating section for generating a readout control signal for performing readout control of said existing data and a write control signal for performing write control of said new data, and by configuring so that said existing data and said new data are compared with each other in said comparison section in accordance with said write control signal from said control signal generating section.

"[A] control signal generating section for generating a readout control signal for performing readout control of said existing data and a write control signal for performing write control of said new data."

Searby does not disclose a "control signal generating section." On page 5 the Office Action admits that Searby does not disclose a "control signal generating section," further alleging that Searby would inherently contain a *control signal generating section* by reciting that "the control signal generating section, while not shown, must exist in order for the circuit and know when to read control image data K and brush coefficient K_B."

To account for these deficiencies within <u>Searby</u>, the Final Office Action concludes, *<u>without providing any supporting evidence</u>*, that these features are "inherent."

The Courts ***have not*** *upheld arguments based on 'inherent' properties when there is **<u>no</u> <u>supporting teaching</u>** in the prior art"* (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). Instead, the Office Action must provide rationale or evidence tending to show inherency. M.P.E.P. § 2112(IV).

The mere fact that a certain thing *<u>may result</u>* from a given set of circumstances *<u>is not</u> <u>sufficient</u>* to show an inherent anticipation. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Specifically, the fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Instead, inherency requires that the missing descriptive material is "*<u>necessarily present</u>*," **not**

11

merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

For inherency to apply, a result cannot be feasible by any other method. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter 1990).

In the present case, there is no basis for the allegation that a control signal generating section inherently exists in Searby. Furthermore, there is no basis for the proposition that the non-existent control signal generating section produces a **readout control signal and a write control signal.**

On the contrary, the architecture of Searby makes it possible for the comparator 13 to issue a write signal to gate 15, whenever K differs from K_B. The fact that the comparator output is coupled to a gate suggests that Searby does not require a control signal generator that produces a distinct read and write signal, as the output of the comparator produces the write signal for the gate 15.

Instead, the design of the Searby device allows the comparator to operate by streaming in the new data K_B and new data K without the use of a specific read signal, i.e. without receiving a specific read or write signal.

The implementation of the Searby device, which omits the signal generating section as described in the independent claims contradicts the assertion of inherency set forth in the final action.

- Therefore, Searby does not *inherently* teach or disclose "*a control signal generating section for generating a readout control signal for performing readout control of said existing data and a write control signal for performing write control of said new data.*"

12

"[S]aid existing data and said new data are compared with each other in said comparison section in accordance with said write control signal from said control signal generating section."

For the reasons set forth above, Searby does not disclose a "control signal generating section."

Furthermore, Searby does not disclose that the comparator 13 disclosed in Searby operates in accordance with a write signal. As evidenced by figure 1, Searby does not teach or suggest that the comparator accepts any control signals. Instead, the comparator 13 simply produces a write signal as a result of the input of the new and existing data, i.e., K and K_B. There is no suggestions in Searby that the comparator is responding to a write signal, but is in fact only responding to the new and existing data.

- Therefore, Searby does not *inherently* teach or disclose "*said existing data and said new data are compared with each other in said comparison section in accordance with said write control signal from said control signal generating section."*

Response to Examiner's Response

Page 4 of the Office Action attempts to counter Applicant's assertion of inherency. The Office Action asserts that the read control signal and write control signals would be inherently present given the need to read memory. However, this is not the issue.

Specifically, Searby does not disclose a "*a control signal generating section for generating a readout control signal ... and a write control signal,"* wherein the *write control signal from the control signal generating section operated the comparator*. The inherent need for a signal generating component to operate the memory device in Searby does not make it inherent that the devices will have the same features as the claimed *control signal generating section, i.e., that the control signal generating section would produce a read and write control signal, where the write control signal drives the comparator.*

13

CONCLUSION

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2624 from which the undersigned is authorized to draw.

Dated: *August 9, 2007*

Respectfully submitted,

By _____

Ronald P. Kananen
   Registration No.: 24,104
N. Meyer Zohn
   Registration No.: 55,761
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 23353
Attorneys for Applicant